

**BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS**

In re Application of: Glenn R. Godley)	Date: March 31, 2009
)	
Serial No.: 09/778,543)	Group Art Unit: 3714
)	
Filed: 02/07/2001)	Examiner: Banafsheh Hadizonooz
)	
Title: Vocal Training and)	
Companionship Apparatus)	
_____)	

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450 Alexandria, VA 22313-1450 on _____ (Date)

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BRIEF ON APPEAL UNDER 37 C.F.R. 41.31

Hon. Commissioner of Patents and Trademarks
P.O. Box 150
Alexandria, VA 22313

Dear Board:

This Appeal is submitted under 37 C.F.R. 41.31 in reply to the Notice of Non-Compliant Appeal Brief (37 C.F.R. 41.37) of April 23, 2009.

REAL PARTY IN INTEREST

The real parties of interest in this appeal is OurPet's Corporation, an Ohio company and assignee of the rights to the present technology, and who has commercialized products based thereon.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to appellant, appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

At present, Claims 1, 2, 4-16, 18 and 19 are the claims rejected for purposes of the Appeal. Claims 3 and 17 were previously cancelled.

STATEMENT OF AMENDMENTS

There are no supplemental amendments filed after the most recent rejection.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Referring now to **FIG. 1** through **FIG. 6** and the specification page 6, line 4 through page 11, line 9, a preferred recordable training device **10** for use with a bird is described in accordance with a preferred embodiment of the present invention. The training device **10** includes a reflecting mirror **12**, allowing the bird to view its own reflection, thereby providing the bird with a sense of

companionship. However, pictures such as those of another bird, or other stimulation device could be used in lieu of the mirror 12. Sensor 14 detects the presence of the bird and initiates the playback of a prerecorded voice or sound message recorded by the bird's owner or trainer.

One preferred sensor 14 is a motion sensor, whereby the movement of the bird will initiate the playback of the prerecorded message. Further embodiments are contemplated for the sensor 14, such as a light sensor, which is activated when light is cut off from the sensor as a result of the bird's proximity to the training device 10. A heat sensor may also be used whereby the heat of the bird's body activates the sensor 14 and initiates the playback of the prerecorded message. A laser and laser-sensing device could also be utilized, whereby the bird's presence near the training device 10 would block the laser beam, thereby initiating the playback of the prerecorded message. The mirror 12 and sensor 14 are encased in a polypropylene frame 16, however materials such as plastic or metal may be used.

Perch assembly 18 contains left 22 and right 24 members, which support the bird's perch 20. The opening 30 of perch assembly 18, as shown in FIG. 3 allows the perch assembly 18 to connect the base 28 of training device 10 as shown in FIG. 2, by a snap fit, screws, press fit, or any other suitable means known by one with ordinary skill in the art. However, this perch assembly 18 may be integrated into the design of the housing 16 without being a separate piece. By connecting the perch assembly 18 to the base 28 of the training device 10, a fully integrated bird perch is created. The perch 20 allows the bird to be in close proximity with the training device 10 and sensor 14. Because the bird is in close proximity to the sensor 14 accurate playback is initiated only by the bird's movement not by collateral external activity. In addition, the present invention has the option of not using the perch assembly 18 in conjunction with base

28 of the training device 10. Furthermore, the present invention 10 may include a seed or water trough 26 that can be inserted into the void (open space) 31 created by the perch assembly 18, as shown in FIG. 3.

FIG. 4 illustrates the reverse side of the training device 10. The present invention 10 includes a battery cover 32, which is slideably removed for gaining access to a battery compartment. To position or mount the training device 10, the device may be oriented so that it simply sits on a floor or table, or other surface. Furthermore, the training device can be affixed in a desired position using a common means of attachment such as a bracket, adhesives, loop and hook, or any other suitable means known by one of ordinary skill in the art. In this embodiment, the training device 10, mounting pins 36, 38, 40, 42 and threaded pin 44 of the training mirror 10 are positioned through the bars of the bird's cage. A mounting plate 34 as shown in FIG. 5 is arranged so that the mounting plate holes 70, 72, 74, 76, and 78 allow the mounting pins 36, 38, 40, 42, and threaded pin 44 of training device 10 to pass through. To secure the training mirror 10, a thumb wheel 46 is threaded onto threaded pin 44. By tightening the thumb wheel 46, a compressive force is created by the mounting plate 34 and the training device 10 against the birdcage, thereby holding the training device 10 in the desired position.

To prepare the present invention 10 for use, the on/off switch 50 is put into the "ON" position. By putting the on/off switch 50 into the "ON" position, the present invention 10 is both ready to record and ready to detect the presence of the bird. Next, to record a message, the record button 58 is depressed, which illuminates an LED light 52 indicating that the training device 10 is ready to record a message. While continuing to depress the record button 58, the user records the desired sound that he or she wishes the bird to learn while speaking into the

microphone 54. This phrase or message may be comprised of a song, whistles, the trainer's own voice, or any other audible sound that the trainer desires the bird to emulate. However, the training device 10 could be designed to record and playback sounds that are not audible to humans but are recognizable by animals such as birds. The user is given a predetermined amount of time in which a message can be recorded. If the user attempts to record a message that is longer than the specified limit, the LED indicator 52 will stop illuminating and the recording function will stop. In the event that the user elects to record a phrase that is shorter than the device's maximum time limit, the user, may release the record button 58 to stop the recording process at the desired point.

Once the recording process is completed the message is stored by the invention's memory, and the user may replay it by depressing the play button 56. Once the play button 56 is depressed, the playback speaker 48 transmits the playback. By playing back the recorded message, the user can test the clarity and volume of the recorded sound. After the message is recorded, the training device 10 is ready for use, and playback of the prerecorded message will be initiated when the sensor 14 detects the presence of the bird near the training mirror 10. By putting the on/off switch 50 into the "OFF" position, the recording and playback feature of the training device 10 is made inoperable. To erase a previous recorded message, the owner simply re-records a new message by depressing and holding the record button 58, which initiates the aforementioned recording sequence. A preferred embodiment which does not include the perch assembly 18 and trough 26 is suitable for applications for training subjects such as animals and children.

Further embodiments of the present invention 10 may be comprised of a playback system without a recording feature. The playback system would contain prerecorded phrases, whistles,

or any other sound that is audible to an animal or human. A selector switch may then be used to choose the desired message to be played. Also, a volume control feature is contemplated wherein the sound output level of the training device **10** may be reduced or increased via a volume control. Additionally, a system that would increase or decrease the frequency in which the recorded sound is played back independently of the detection by the sensor **14** is also contemplated.

The preferred embodiment illustrated in **FIG. 6** describes a training device **10** that can be used for subjects such as animals or children in general. This preferred embodiment of the present invention **10** is identical to the aforementioned preferred embodiment, which is used for a bird, with the exception of the bird perch assembly **18**, which is unnecessary. Specifically, training device **10** contains a mirror **12** that provides an incentive for the subject to engage in interacting with the training device **10**. However, a picture of the child's mother or father, picture of another animal, or other type of comforting image may be substituted in place of the training device's mirror **10**. A sensing device **14** is used to detect the presence or absence of the subject and to initiate the playback of the recorded sound. To mount the training device **10**, any typical means of attachment such as adhesives, hook and loop, or any other type of attachment means known by one skilled in the art may be used. Furthermore, the training device **10** is capable of freely standing alone in a desired position without the need of any attachment or mounting means.

Mapping of the Independent Claims:

1. An apparatus to teach a subject to vocally emulate sounds comprising:

a presence detecting sensor for detecting the presence of a subject;	One preferred sensor 14 is a motion sensor, whereby the movement of the bird will initiate the playback of the recorded message. Further embodiments are contemplated for the sensor 14, such as a light sensor, which is activated when light is cut off from the sensor....A heat sensor....a laser and laser sensing device... (Spec. Pg. 4, ll. 12-19).
a system for playing back a predetermined message, wherein said system initiates playback of said predetermined message upon detection of the presence of said subject by said presence detecting sensor; and	Sensor 14 detects the presence of the bird and initiates the playback of a prerecorded voice or sound message (Spec. Pg. 4, ll. 9-11).
a housing which contains said sensor and said playback initiation system.	The mirror 12 and sensor 14 are encased in a polypropylene frame 16 (Pg. 4, line 19).

18. A method of teaching a subject to vocalize sounds comprising:

selecting prerecorded sound to be played back by a playback system;	The playback system would contain prerecorded phrases, whistles, or any other sound that is audible to an animal or human. A selector switch may then be used to choose the desired message to be played (Pg. 7, ll. 6-8).
detecting said subject's presence by a presence detecting sensor; and	Sensor 14 detects the presence of the bird and initiates the playback of a prerecorded voice or sound message (Spec. Pg. 4, ll. 9-11).
upon the sensor's detection of said subject, the prerecorded sound is played back for said subject to hear, whereby said subject learns to vocally emulate a desired sound.	One preferred sensor 14 is a motion sensor, whereby the movement of the bird will initiate the playback of the recorded message. Further embodiments are contemplated for the sensor 14, such as a light sensor, which is activated when light is cut off from the sensor....A heat sensor....a laser and laser sensing device... (Spec. Pg. 4, ll. 12-19).

19. An apparatus to teach a subject to vocally emulate sounds comprising:

a housing, said housing comprising an front portion and a back portion;	Housing 16 is shown in FIG. 1.
a presence detecting sensor, said presence detecting sensor located at said front portion for detecting the presence of said subject;	One preferred sensor 14 is a motion sensor, whereby the movement of the bird will initiate the playback of the recorded message. Further embodiments are contemplated for the sensor 14, such as a light sensor, which is activated when light is cut off from the sensor....A heat sensor....a laser and laser sensing device... (Spec, Pg. 4, ll. 12-19)(FIG. 1).
a system for playing back a predetermined message, said system located at said back portion, and wherein said system initiates playback of said predetermined message upon detection of the presence of said subject by said presence detecting sensor;	Sensor 14 detects the presence of the bird and initiates the playback of a prerecorded voice or sound message (Spec, Pg. 4, ll. 9-11) (FIG. 4).
a mirror, said mirror affixed to said front portion; and	The training device 10 includes a reflecting mirror 12 (Pg. 4, ll. 4-5)(FIG. 1).
a perch assembly, said perch assembly coupled to a lower portion of said housing.	The opening 30 of the perch assembly 18, as shown in FIG. 3, allows the perch assembly 18 to connect the base 28 of the training device 10 as shown in FIG. 2, by snap fit, screws, press fit... (Pg. 4, ll. 21-23).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal include:

- (a) Are Claims 1, 2, 5, 9, 11, 12, 18 and 19 anticipated by Hicks under 35 U.S.C. § 102(b)?
- (b) Are Claims 1, 4, 5, 8 and 19 anticipated by Yu under 35 U.S.C. § 102(b)?
- (c) Is Claim 2 unpatentable over Hicks in view of Lynch under 35 U.S.C. § 103(a)?

(d) Are Claims 6-8 unpatentable over Hicks in vie of Yu under 35 U.S.C. § 103(a)?

(e) Are Claims 10 and 13-16 unpatentable over Hicks in view of Green under 35 U.S.C. § 103(a)?

ARGUMENT

1. Rejections Under 35 U.S.C. § 102(b)

In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(b), a primary tenet is that the reference must teach every element of the claim(s). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

(a) The examiner respectfully rejected Claims 1, 2, 4-5, 9, 11, 12, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hicks.

The examiner cited Hicks as disclosing a sensor for detecting the presence of a subject and a housing containing the sensor. However, what is disclosed in Hicks is not a sensor but a mechanical lever sensitive to the weight of a bird. As such, Hicks fails to disclose every element of Claims 1 and 18 as required, thus Claims 1 and 18 are considered allowable. And, because Claims 2, 4-5, 9-12 and 15 depend from Claim 1, Claims 2, 4-5, 9-12 and 15 are also considered allowable.

In regard to Claims 9 and 10, specifically, the invention as disclosed by Hicks includes a

perch that is detachable. However, the perch is used to activate the prerecorded message once a bird activates the playback via the weight sensitive perch. If the perch is removed (because it is detachable), it fails to operate and anticipate the present invention as claimed. As such, Claims 9 and 10 are further considered allowable.

(b) The examiner respectfully rejected Claims 1, 4, 5, 8 and 19 under 35 U.S.C. § 102(b) as being anticipated by Yu.

The Yu reference discloses a lighting fixture with *motion* detector and announcement device, wherein a person or object entering into a monitored area triggers the announcement device to deliver a prerecorded message.

In contrast, the present invention claims a *presence* detector and initiation of playback of the prerecorded message based on the *presence* of an object. Motion is distinct from presence, as the mere presence of an object in an area would not necessarily trigger the motion detector. Conversely, mere motion would not trigger the presence detector. Therefore, a distinct difference exists between the motion detector claimed in Yu and the presence detector in Claim 1 of the present invention.

Because Yu fails to disclose every element of Claim 1, and dependent Claims 4, 5, 8 and Claim 19, the Examiner's rejection of Claims 1, 4, 5, 8 and 19 is inappropriate.

2. Rejections under 35 U.S.C. 103(a)

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP §

706.02(j). In assessing whether subject matter would have been non-obvious under § 103, the Board follows the guidance of the Supreme Court in Graham v. John Deere Co. The Office determines "the scope and content of the prior art," ascertains "the differences between the prior art and the claims at issue," and resolves "the level of ordinary skill in the pertinent art." Dann v. Johnston, 425 U.S. 219, 226 (1976) (quoting Graham, 383 U.S. at 17). Against this background, the Office determines whether the subject matter would have been obvious to a person of ordinary skill in the art at the time of the asserted invention. Graham, 383 U.S. at 17. In making this determination, the Office can assess evidence related to secondary indicia of non-obviousness like "commercial success, long felt but unresolved needs, failure of others, etc." Id., 383 at 17-18; accord Rouffett, 149 F.3d at 1355.

To reject claims in an application under section 103, an examiner must show an unrebutted prima facie case of obviousness. On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness. Rouffett, 149 F.3d at 1355.

Most inventions arise from a combination of old elements and each element may often be found in the prior art. Id. at 1357. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. Id. at 1355, 1357. Rather, to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. Id. In practice, this requires that the Board "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." Id. at 1357-59. This

entails consideration of both the "scope and content of the prior art" and "level of ordinary skill in the pertinent art" aspects of the Graham test.

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (internal citations omitted). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59.

This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decision making, as it is in § 103. See *id.* at 1344-45.

In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. See, e.g., Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc., 424 F.3d 1293, 1323 (Fed. Cir. 2005) ("One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings."); Ecolochem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1372 (Fed. Cir. 2000) ("Although the suggestion to combine references may flow from the nature of the problem, '[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant

to obviousness.'" (internal citation omitted) (quoting Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed. Cir. 1998))); In re Beattie, 974 F.2d 1309, 1312 (Fed. Cir. 1992) ("[T]he law does not require that the references be combined for the reasons contemplated by the inventor."); Princeton Biochemicals, Inc. v. Beckman Coulter, Inc., 411 F.3d 1332, 1337 (Fed. Cir. 2005) (characterizing the relevant inquiry as "[would] an artisan of ordinary skill in the art at the time of the invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention,[] have selected the various elements from the prior art and combined them in the manner claimed"); see also Graham, 383 U.S. at 35 (characterizing the problem as involving mechanical closures rather than in terms more specific to the patent in the context of determining the pertinent prior art). Therefore, the "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims. See Cross Med. Prods., 424 F.3d at 1321-24. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art—i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention—support the legal conclusion of obviousness. See Princeton Biochemicals, 411 F.3d at 1338 (pointing to evidence supplying detailed analysis of the prior art and the reasons one of ordinary skill would have possessed the knowledge and motivation to combine).

Additionally, appellant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. 103,

the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

The Court of Appeals for the Federal Circuit (CAFC) in its opinion in In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988), (later upheld in In re Dance, 160 F.3d.

1339, 48 USPQ 2d. 1635 (Fed. Cir. 1998), sets forth the test of how the disclosure or teaching of references should be applied under 35 USC §103:

Obviousness I "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so". Id., Here, the prior art contains none. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

- (a) The examiner respectfully rejected Claims 2 under 35 U.S.C. § 103(a) as being unpatentable over Lynch.

Claim 2 discloses a selector switch for selecting between prerecorded sounds. The examiner has admitted this laps, yet still rejects Claims 2. The applicant feels that the examiner has failed to meet the evidentiary burden required by providing evidence that the claimed elements and/or features are disclosed, taught, suggested and/or claimed by the prior art cited. Failure to meet this burden is indicative of the patentability of the claims in question, and as such, Claims 2 is considered allowable.

- (b) The examiner respectfully rejected Claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Hicks, in view of Yu.

Claims 6-8 disclose different presence detecting sensors, one having a light sensing device, one having a laser and laser detection sensor and a heat sensing device, respectively. The examiner has admitted that Hicks fails to specifically disclose these different presence detectors, yet still rejects Claims 6-8 as unpatentable based on obviousness to one of ordinary skill in the art. The applicant feels that the examiner has failed to meet the evidentiary burden required by providing evidence that the claimed elements and/or features are disclosed, taught, suggested and/or claimed by the prior art cited. Failure to meet this burden is indicative of the patentability of the claims in question, and as such, Claims 6-8 are considered allowable.

- (c) The examiner respectfully rejected Claims 10 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Hicks in view of Green.

Green is cited in combination with Hicks as disclosing every element of Claims 10 and 13-16. However, Green has an issue date of March 12, 2002, more than a year after the filing date of the present invention, and discloses a garden accessory system, a nonanalogous art as well. As such, every element of Claims 10 and 13-16 are not disclosed, taught, suggested or claimed by the combination of Hicks and Whitaker, therefore Claims 10 and 13-16 should be considered allowable.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima*

facie rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

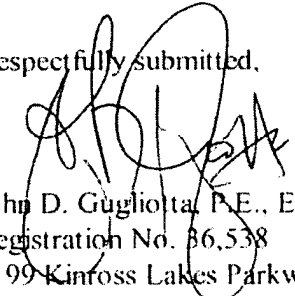
There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a vocal training apparatus having a presence detector and a playback system based on the actuation of the presence detector. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the

knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,



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APPENDIX

THE CLAIMS ON APPEAL

The claims on appeal are as follows:

1. An apparatus to teach a subject to vocally emulate sounds comprising:
a presence detecting sensor for detecting the presence of a subject;
a system for playing back a predetermined message, wherein said system initiates playback of said predetermined message upon detection of the presence of said subject by said presence detecting sensor; and
a housing which contains said sensor and said playback initiation system.
2. An apparatus as recited in claim 1 further comprising a system for selecting a prerecorded sound to be played, wherein said system comprises a selector switch for choosing a desired prerecorded sound.
3. (Canceled).
4. An apparatus as recited in claim 1 further comprising a system for recording sounds that are audible to animals.
5. An apparatus as recited in claim 1 wherein said presence detecting

sensor comprises a movement sensing device.

6. An apparatus as recited in claim 1 wherein said presence detecting sensor comprises a light sensing device for detecting the absence of light due to the presence of said subject.

7. An apparatus as recited in claim 1 wherein said presence detecting sensor comprises a laser and a laser detection sensor.

8. An apparatus as recited in claim 1 wherein said presence detecting sensor for detecting the presence of said subject comprises a heat sensing device.

9. An apparatus as recited in claim 1, further comprising a bird perch, said bird perch for holding said subject, said subject being a bird.

10. An apparatus as recited in claim 9, wherein said bird perch is detachable.

11. An apparatus as recited in claim 1, further comprising a mirror.

12. An apparatus as recited in claim 11, wherein said mirror is contained within said housing, said mirror providing visual stimulation to said subject.

13. An apparatus as recited in claim 1, further comprising a means for attaching said apparatus to a birdcage.
14. An apparatus as recited in claim 13 wherein, said means for attaching said apparatus to said birdcage comprises a bracket.
15. An apparatus as recited in claim 1 wherein, said apparatus is capable of freely standing.
16. An apparatus as recited in claim 9 further comprising a trough, wherein said trough is inserted within a space formed within said bird perch.
17. (Canceled).
18. A method of teaching a subject to vocalize sounds comprising:
selecting a prerecorded sound to be played back by a playback system;
detecting said subject's presence by a presence detecting sensor; and
upon the sensor's detection of said subject, the prerecorded sound is played back for said subject to hear, whereby said subject learns to vocally emulate a desired sound.
19. An apparatus to teach a subject to vocally emulate sounds

comprising:

a housing, said housing comprising an front portion and a back portion;

a presence detecting sensor, said presence detecting sensor located at said front portion
for detecting the presence of said subject;

a system for playing back a predetermined message, said system located at said back
portion, and wherein said system initiates playback of said predetermined message upon detection
of the presence of said subject by said presence detecting sensor;

a mirror, said mirror affixed to said front portion; and

a perch assembly, said perch assembly coupled to a lower portion of said housing.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDING

None.